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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,313	02/11/2000	Keith Rose	1142	4981

7590 07/05/2007  
Charles E Gotlieb  
540 University Avenue  
Suite 300  
Palo Alto, CA 94301

EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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07/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/502,313

Applicant(s)

ROSE ET AL.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to applicants' communication filed on 4/2/2007.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (USPAP 2003/0135457 A1) ("Stewart") in view of D'Amico et al (USPAP 2001/0034641 A1) ("D'Amico"), and further in view of Ricketts et al (USPN 6901383) ("Ricketts").

Stewart disclose a method and apparatus for providing online financial account services comprising receiving a subscription to open and fund a new deposit account online through a web site of a financial institution 10. The customer 20 is directed to the web site of the financial institution by web-based advertising or other links, by a web search engine or by directly entering the site's URL address in a web browser. The web site provides information related to accounts and other services offered by the financial institution (see page 5, paragraph (0057)). Stewart disclose that the financial institution 10 can be a bank or any other type of financial or investment services company offering deposit based services and that the deposit account can be a checking or savings account, a certificate of deposit, a money market account or any other suitable financial account (see page 2, paragraph (0016)).

Stewart does not specifically disclose that the financial account to be opened by the customer 10 at the investment services company can be a mutual fund account and providing the total number of subscribers at the end of the subscription period.

D'Amico discloses prospective customers purchasing shares of a mutual fund by contacting the mutual fund on the Internet, requesting an application and then submitting the completed application along with the appropriate funds to the fund advisor (see page 3, paragraph (0047)).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made, in view of the teachings in D'Amico, to allow a customer of the Stewart method, to both open and fund a mutual fund account over the Internet, thereby expanding the customers investment options and enabling the customer to buy and sell mutual fund shares online.

Ricketts discloses determining the total number of investors (subscribers) for each series 602, period 604 and date 416 (see col. 17, lines 7-8, col. 8, lines 11-13).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made, in view of the teachings in Ricketts, to allow the financial institution of the Stewart method, to track the number of customers that open and fund a mutual fund account within a time period.

Regarding claims 5 and 13, the examiner takes official notice that a series of linked web pages where the user can create a new account is old in the art (see the cited reference to Joseph (USPAP 20010034690, paragraph (0039) and Rinaldi (USPAP 20020016756, paragraph (0028))). In view of this official notice, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to modify the user interface of the Stewart/D'Amico/Ricketts combination method with linked web pages, so as to utilize a well-known and convenient user-friendly interface.

Regarding claims 7, 8, 15 and 16, the examiner takes official notice that scrolling banner and animated banner advertisements are well known in the art of advertising on the web. In view of this official notice, it would have been obvious to one of ordinary skill in the art at the time that the invention was made, to use banner advertising at the users computer interface in the Stewart/D'Amico/Ricketts combination method and thereby avail of an efficient and proven method of advertising on the internet.

*Response to Arguments*

Applicant's arguments, see "Remarks" (page 7), filed 4/2/2007, with respect to the rejections of claims 1-16 under 35 U.S.C. 103(a) have been fully considered and are not persuasive.

The applicant argues that the Ricketts reference does not show that the total number of subscribers of a mutual fund is provided to mutual fund management responsive to the end of a subscription period. Examiner respectfully disagrees. The Examiner has established the obviousness of establishing and subscribing to an online mutual fund. Examiner asserts that the specific step of providing this information to the management is obvious because all the information (including the total number of subscribers and the number of units bought per subscriber) associated with the subscription as gathered by a host server (subscription details sent by subscriber and stored in a host) would be accessible to the asset managers for processing and accountability purposes (i.e. total number of units/shares purchased as well as for gain/revenue/dividend reporting and/or sharing).

Ricketts reference teaches the concept of determining the total number of investors (including investors in mutual funds) for a given period (see col. 17, lines 7-8, col. 8, lines 11-13).

With respect to applicant's challenge of the Official notice, the examiner notes that the Official notice was taken before the Board of Appeal decided the case. Therefore, examiner asserts that this feature is considered to be admitted prior art (since applicant did not challenge this previously in a timely manner). See also Rinaldi (USPAP 20020016756, paragraph (0028))

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", written in a cursive style.

ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER